

Application No. 09/966,522
Amendment Under 37 CFR § 1.111
Reply to Office Action of January 14, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants point out that they have filed simultaneously with this amendment an information disclosure statement citing two new references which may be of relevance to the instant application. In case the information disclosure statement has not been matched with the file at the time that the Examiner picks up the file for action, Applicants respectfully request that the Examiner try to locate the information disclosure statement, and, if it

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cannot be located, that the Examiner contact the undersigned at telephone number 212-808-0700 so that a duplicate copy of the information disclosure statement can be provided.

Turning to the open Office Action, Applicants affirm their election with traverse to prosecute in this application the subject matter of Group II, claims 17-23.

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement, or at least modify it to the extent that the withdrawn subject matter will be rejoined in examined in the event that the elected subject matter is found to be allowable. According to the Examiner, each of the four categories of claimed subject matter are unrelated. Applicants submit that this is incorrect.

As will be explained in further detail below, the present invention embodies a novel and unobvious combination of (1) a fluorescent dye and (2) a masking dye. This novel and unobvious combination is present in every single claim on file. Accordingly, Applicants submit that the finding that the elected subject matter is allowable because this novel and unobvious combination is not found in the prior art necessarily means that each and every claim presently on file is novel and unobvious over prior art for exactly the same reason.

Therefore, the Examiner should reconsider and withdraw the restriction requirement altogether. Failing that, Applicants respectfully submit that at least the nonelected subject matter

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should be rejoined and examined in the event that the elected subject matter is found to be allowable because the claimed combination of (1) a fluorescent dye and (2) a masking dye is novel and unobvious over the prior art.

Claims 17-22 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have amended claim 17 to replace “said photon reducing agent” by -- said masking agent --. Claim 22 has been amended to provide the chemical name for Brilliant Black. Neither of these amendments is believed to introduce any new matter. Respecting the change to claim 22, Applicants attach an excerpt from the P.D. Industries’ Food Dyes website showing the chemical name for Brilliant Black.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Claims 17-20 and 23 were rejected under 35 USC § 102(e) as being anticipated by Cubbage et al. (“Cubbage”), U.S. Patent No. 5,582,982. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the

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reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.* In response, Applicants submit that Cubbage does not teach each and every limitation of the rejected claims, and, therefore, also that Cubbage does not anticipate the present claims.

Instant claim 17 requires that (1) the “masking dye is substantially impermeant to the membrane of a biological cell” and (2) the “masking dye does not specifically bind to [a] membrane of [a] biological cell.” The other rejected claims incorporate these same requirements by their dependence on claim 17.

Cubbage expressly teaches, for example, at column 3, lines 41-43, that “the background-reducing compound will diffuse onto and into the biological entity.” In the case where the biological entity is, for example, a cell, this means that the background-reducing compound will bind to the target cell and will also substantially penetrate the membrane of the target cell to be incorporated inside said target cell.

These actions are not permitted according to instant claim 17 and the rejected claims dependent thereon. Consequently, Cubbage cannot possibly anticipate any of the rejected claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection also. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Claim 22 was rejected under 35 USC § 103(a) as being obvious over Cubbage in view of Van Aken, U.S. Patent No. 5,489,537. In response, Applicants point out that this rejection was dependent upon Cubbage constituting a teaching of the basic aspects of the present invention. Thus, Van Aken is relied upon to teach Brilliant Black as a masking dye. Van Aken is not relied upon to teach any of the deficiencies of Cubbage as discussed above. Accordingly, the combination of Cubbage and Van Aken, even if Van Aken would have rendered *prima facie* obvious the use of Brilliant Black as a masking dye, would not have rendered claim 22 *prima facie* obvious since the combination of Cubbage and Van Aken still fails to teach or suggest the deficiencies of Cubbage as discussed above.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

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Applicants further believe that this application is in condition for immediate allowance. However, should the Examiner determine that any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

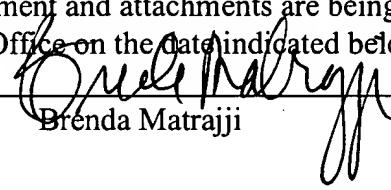
Respectfully submitted,
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CERTIFICATE OF EXPRESS MAIL

I hereby certify that the foregoing Amendment and attachments are being sent via Express Mail to the United States Patent and Trademark Office on the date indicated below:

Date: July 14, 2004

By _____

Brenda Matraji